UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/507,093	02/17/2000	Hyung-sik Choi	YPLA0002	7685

7590   06/05/2002

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EXAMINER
FARISS, TIMOTHY

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 06/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

	Application No.		Applicant(s)	
Office Action Summary	09/507,093		CHOI, HYUNG-SIK	
	Examiner		Art Unit	
	Timothy Fariss		3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _17 February 2000_ .

2a)☐ This action is **FINAL**.　　2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-12_ is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-12_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

　　If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☒ All　b)☐ Some *　c)☐ None of:

　　　1.☒ Certified copies of the priority documents have been received.

　　　2.☐ Certified copies of the priority documents have been received in Application No. _____ .

　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
　　　　application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

　　a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _2_ .

4)☐ Interview Summary (PTO-413) Paper No(s). _____ .
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: .

DETAILED ACTION

Specification

The specification is objected to because of the following informalities: grammatical

errors. Page 1, Line 6 reads, "...in which advertisement is included..." Page 1, Line 12 reads,

"...a flood of advertisement." The applicant is encouraged to review the application and claims

for other grammatical errors. Appropriate correction is required.

The abstract of the disclosure is objected to because the abstract in an application filed

under 35 U.S.C. 111 may not exceed 150 words in length. Correction is required. See MPEP

§ 608.01(b).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on
> sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United
> States before the invention thereof by the applicant for patent, or on an international application by another who
> has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention
> thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999

(AIPA) do not apply to the examination of this application as the application being examined

was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C.

122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment

by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 2, 4, 5, 6, and 8 are rejected under 35 U.S.C. 102(b) as being clearly anticipated

over Petrecca et al. (U.S. 5,781,894).

Claim 1 is rejected because Petrecca teaches an advertising method using software

products wherein an advertisement is included in at least a part of a program of a software

product supported by an advertisement sponsor, and a program user obtains the program for free

or at low cost so that the user of the software product is forced to see the advertisement of the

advertisement sponsor during use of the software program (Column 1, Lines 43-54; Column 2,

Lines 15-42).

Claim 5 is rejected because Petrecca teaches the position of is not limited and inserted in

an arbitrary position of the program to be reproduced (Column 1, Lines 33-54), an in the case of

a recording medium used in a computer, even when the operation of the program is competed on

the Internet, a window can exist as another open window (Column 1, Lines 20-23).

Claim 2 is rejected because Petrecca teaches an advertising method using software

products, wherein a software program included in a recording medium where an advertisement

of an advertisement sponsor is included in at least a part thereof is downloaded from the Internet

for free or at a low cost so that a user uses the software program while watching the

advertisement (Column 1, Lines 28-40; Column 2, Lines 15-42).

Claim 6 is rejected because Petrecca teaches the position of is not limited and inserted in an arbitrary position of the program to be reproduced (Column 1, Lines 33-54), an in the case of a recording medium used in a computer, even when the operation of the program is competed on the Internet, a window can exist as another open window (Column 1, Lines 20-23).

Claim 4 is rejected because Petrecca teaches an advertising method using software products, wherein an advertisement program is inserted in at least a part of the software program, and when a recording medium where the software program is stored is reproduced in a computer and a video/audio reproducing apparatus, the advertisement program inserted in at least a part of the software program is reproduced (Column 1, Lines 43-54).

Claim 8 is rejected because Petrecca teaches the position of is not limited and inserted in an arbitrary position of the program to be reproduced (Column 1, Lines 33-54), an in the case of a recording medium used in a computer, even when the operation of the program is competed on the Internet, a window can exist as another open window (Column 1, Lines 20-23).

Claims 3 and 7 are rejected under 35 U.S.C. 102(a) as being anticipated by Horstmann (U.S. 6,285,985).

Claim 3 is rejected because Horstmann teaches an advertising method using software products, wherein, when a software program including an advertisement in at least a part thereof is used, as the advertisement sponsor links to a web site such as the home page of an advertisement sponsor, the web site is easily accessed by clicking on the web site address (Column 3, Lines 1-5; Column 4, Lines 10-17).

Claim 7 is rejected because Horstmann teaches the position of is not limited and inserted in an arbitrary position of the program to be reproduced, an in the case of a recording medium

used in a computer, even when the operation of the program is competed on the Internet, a

window can exist as another open window (Column 4, Lines 27-40).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 9, 10, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Petrecca et al. (U.S. 5,781,894) in view of Guyot et al. (U.S. 6,119,098).

Claim 9 is rejected because Petrecca teaches an advertising method using software

products, but fails to teach an advertisement of a single advertisement sponsor can be included in

a software product, advertisements of a plurality of advertisement sponsors can be included in a

software product, advertisements of a plurality of advertisement sponsors can be included

according to their portions of support, only an advertisement of a single advertisement sponsor or

advertisements of a plurality of advertisement sponsors can be included according to their

portions of support in a plurality of software products, financial portions of an advertisement

support can be determined according to the number of distributed software products, and the

financial portions of an advertisement support can be determined according to the number of

downloads of the software product. However, Guyot teaches an advertisement of a single

advertisement sponsor can be included in a software product, advertisements of a plurality of

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advertisement sponsors can be included according to their portions of support, only an

advertisement of a single advertisement sponsor or advertisements of a plurality of advertisement

sponsors can be included according to their portions of support in a plurality of software

products, financial portions of an advertisement support can be determined according to the

number of distributed software products, and the financial portions of an advertisement support

can be determined according to the number of downloads of the software product (Column 4,

Lines 1-14; Column 10, Lines 10-29). It would have been obvious to one skilled in the art at the

time of the applicant's invention to combine the advertising system as per Petrecca with the

method of billing as per Guyot because a sponsor is most willing to pay for a specified amount of

exposure.

Claims 10 and 12 are rejected based on the analysis given for the rejection of Claim 9.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Horstmann (U.S.

6,285,985) in view of Guyot et al. (U.S. 6,119,098).

Claim 11 is rejected because Horstmann teaches an advertising method using software

and Internet links, but fails to teach an advertisement of a single advertisement sponsor can be

included in a software product, advertisements of a plurality of advertisement sponsors can be

included in a software product, advertisements of a plurality of advertisement sponsors can be

included according to their portions of support, only an advertisement of a single advertisement

sponsor or advertisements of a plurality of advertisement sponsors can be included according to

their portions of support in a plurality of software products, financial portions of an

advertisement support can be determined according to the number of distributed software

products, and the financial portions of an advertisement support can be determined according to

the number of downloads of the software product. However, Guyot teaches an advertisement of a

single advertisement sponsor can be included in a software product, advertisements of a plurality

of advertisement sponsors can be included in a software product, advertisements of a plurality of

advertisement sponsors can be included according to their portions of support, only an

advertisement of a single advertisement sponsor or advertisements of a plurality of advertisement

sponsors can be included according to their portions of support in a plurality of software

products, financial portions of an advertisement support can be determined according to the

number of distributed software products, and the financial portions of an advertisement support

can be determined according to the number of downloads of the software product (Column 4,

Lines 1-14; Column 10, Lines 10-29). It would have been obvious to one skilled in the art at the

time of the applicant's invention to combine the advertising system as per Horstmann with the

method of billing as per Guyot because a sponsor is most willing to pay for a specified amount of

exposure.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

Alberts (U.S. 5,937,392) teaches a banner advertising system for use on the Internet

(Column 2, Lines 55-67).

Marsh et al. (U.S. 5,848,397) teaches a scheduling system for advertisements over a

computer system (Column 5, Lines 5-25).

Murphy (U.S. 5,305,195) teaches interactive advertising for on-line terminals (Column 1, Lines 5-42).

Roth (U.S. 6,285,987) teaches an internet advertising system (Column 1, Lines 32-67).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy Fariss whose telephone number is (703) 305-4569. The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached at (703) 305-8469.

The fax numbers for Formal or Official faxes to Technology Center 2100 are (703) 872-9327. Draft or Informal faxes for this Examiner can be submitted to (703) 872-9326. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

tbf

05/23/02

MELANIE A. KEMPER
PRIMARY EXAMINER